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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,237	03/19/2004	Yonghua Song	MP0031RE	6605

26703 7590 08/27/2009

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ART UNIT	PAPER NUMBER
2816	

MAIL DATE	DELIVERY MODE
08/27/2009	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YONGHUA SONG

Appeal 2009-008948
Application 10/804,237
Patent 6,359,499 B1
Technology Center 2800

Decided: August 27, 2009

Before ALLEN R. MACDONALD, *Vice Chief Administrative Patent Judge,* and ROBERT E. NAPPI, and MARC S. HOFF, *Administrative Patent Judges.*

NAPPI, *Administrative Patent Judge.*

DECISION ON APPEAL

Yonghua Song (Appellant) seeks our review under 35 U.S.C. § 134 of the Examiner's decision finally rejecting claims 1 through 45, 47 through 56, 58 through 68, and 70 through 72 in reissue application 10/804,237. The reissue application seeks to reissue U.S. Patent 6,359,499, issued March 19, 2002. The reissue application contains original claims 1 through 44 and newly-added claims 45, 47 through 56, 58 through 68, and 70 through 72. Claims added claims 46, 57 and 69 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

We affirm.

INVENTION

The invention is directed a CMOS device which has a compensation circuit which compensates for changes in voltage levels caused by variations in temperature. See Abstract of U.S. Patent 6,359,494. Claim 1 is reproduced below:

> 1. A temperature and process independent analog integrated circuit comprising:
>
> an analog function core responsive to a first differential input signal and a second differential input signal, and having first and second output terminals;
>
> a first loading device having a first terminal responsive to the first output terminal,
>
> a second terminal responsive to a common mode voltage, and a first control terminal;
>
> a second loading device having a third terminal responsive to the second output terminal, a fourth terminal responsive to the common mode voltage, and a second control terminal; and
>
> a compensation circuit in communication with said first and second control terminals, wherein said compensation circuit comprises:

> a first MOS transistor having a first source in communication with the common mode voltage, a first drain, and a first gate in communication with the first and second control terminals; and
>
> a first differential amplifier having a first input in communication with a first bias voltage source, a second input in communication with the first drain, and an output in communication with the first gate and the first and second control terminals.

REJECTION AT ISSUE

The Appellant seeks review of the Examiner's rejection of claims 1 through 45, 47 through 56, 58 through 68, and 70 through 72 as being based upon a defective reissue declaration because the error identified in the reissue declaration is not an error correctible by reissue under 35 U.S.C. § 251.

ISSUES

Has Appellant shown that the Examiner erred in finding that the reissue declaration is defective because the error identified in the reissue declaration is not an error correctible by reissue?

PRINCIPLES OF LAW

Section 251 of the Patent Act states, in pertinent part:

> Whenever any patent is, through error without any deceptive intention, *deemed wholly or partly inoperative or invalid,* by reason of a defective specification or drawing, or *by reason of the patentee claiming more or less than he had a right to claim in the patent,* the Director shall, on the surrender of such patent and the payment of the fee

> required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

35 U.S.C. § 251 (emphasis added).

The Federal Circuit has stated that "the reissue statute requires that proposals to broaden a patented invention must be brought to public notice within two years of patent issuance. The interested public is entitled to rely on the absence of a broadening reissue application within two years of grant of the original patent." *In re. Graff* 111 F.3d 874, 877 (Fed. Circ. 1997).

The court has found it proper to correct indefinite claims by reissue, even if the indefiniteness is based on lack of antecedent basis such that the reissue claims are not of different scope than the original patent claims. *See e.g., In re Altenpohl*, 500 F.2d 1151 (CCPA 1974). In *Altenpohl*, the CCPA remarked that "35 U.S.C. § 251 is a remedial provision, which should be liberally construed." *Id.* at 1156 (holding that correction of an antecedent basis defect in a claim is proper under 35 U.S.C. § 251 and that "correction of such a defect by reissue should not have to depend on difference in scope of the claim.").

"If the meaning of the claim is discernible, even though the task may be formidable and the conclusion may be one over which reasonable persons will disagree, we have held the claim sufficiently clear to avoid invalidity on indefiniteness grounds" *Exxon Research v U.S.*, 60 USPQ2d 1272, 1276 (Fed. Cir. 2001).

FINDINGS OF FACT

1. US Patent No. 6,359,449 issued on March 19, 2002.
2. Appellant filed an application for reissue on March 19, 2004. The application contained a copy of the patent specification, copy of patent drawings, a preliminary amendment, an information disclosure statement, an associate power of attorney, and an application data sheet. See "Letter Accompanying Reissue Application" received March 19, 2004.
3. The "Letter Accompanying Reissue Application" made no mention as to whether the reissue is to broaden the claims.
4. Appellant's reissue application did not include the statutory fee or a reissue declaration. See "Notice To File Missing Parts of Reissue Application" dated May 19, 2004.
5. Appellant submitted a reissue declaration and appropriate fees on July 12, 2004 more than two years from the issue date of US Patent No. 6,359,449.
6. Appellant's reissue declaration states "I believe that the original above-identified U.S. Patent is partially inoperative by reason of my having claimed less than I had the right to claim in that patent." Declaration para. 4.
7. Appellant's declaration identifies that dependent claims 2 through 9, 23 through 31, and 40 contain a potential ambiguity with reference to antecedent basis for the phrase "analog integrated circuit." Declaration para. 4.

8. Appellant's declaration identifies that dependent claim 3 contains a potential ambiguity with reference to antecedent basis for the phrase "analog integrated core circuit." Declaration para. 4.
9. Appellant's declaration identifies that dependent claims 6, 19, 28, 37 and 42 contain a potential ambiguity with reference to antecedent basis for the phrases "the first conductivity type" and "the second conductivity type." Declaration para. 4.
10. Appellant's declaration identifies that independent claims 18, 22, 32 and 41 along with dependent claims 41 through 44 contain a potential ambiguity with reference to antecedent basis for the phrase "compensation circuit." Declaration para. 4.
11. Appellant's declaration identifies that dependent claim 38 contains a potential ambiguity with reference to antecedent basis for the phrase "first and second loading" Declaration para. 4.

ANALYSIS

Appellant has not persuaded us that the Examiner erred in finding that the reissue declaration does not identify an error in the claims of U.S. Patent 6,359,449. Appellant argues that the statement in paragraph 4 of the reissue declaration which states "I believe that the original above-identified U.S. Paten is partially inoperative by reason of my having claimed less than I had a right to claim in that patent" satisfies the requirement that the applicant believes that the original patent is inoperative or invalid. Brief 9. Further on pages 10 and 11 of the Brief Appellant argues that the further descriptions, in paragraph 4 of the Declaration, of potential ambiguities caused by lack of antecedent basis for several limitations meet the requirement that the reissue

declaration contains a statement of at least one error which is relied upon to support the reissue application.

The Examiner has rejected the reissue declaration as the "potential ambiguities" identified in the reissue declaration are not errors that can be used as the basis for a reissue. Answer 4.

Initially, we note that the statement "I believe that the original above-identified U.S. Patent is partially inoperative by reason of my having claimed less than I had a right to claim in that patent" is not sufficient to establish a reissue application. *See e.g. Ex parte Oetiker*, 1997 WL 1883795, Appeal No. 96-4146 (BPAI 1997) (holding that a reissue declaration which merely repeats the disjunctive statutory language that the error was one of claiming "more or less" than the patentee had a right to claim is an insufficient statement of error to satisfy 35 U.S.C. § 251). Further we note that this statement identifies the reissue as being a broadening reissue. As the declaration was not filed with the reissue application (Facts 2, 4 and 5), there was no mention in the filing of the reissue application that the reissue was to broaden the claims of the patent (Fact 3). Thus, more than two years from the issue of the patent, the declaration filed on July 12, 2004 provided the first notice to the public that the reissue application is a broadening reissue. Our reviewing court has clearly stated that the public must be given notice within two years of the issue data of the original patent that a reissue is broadening the claims of the patent. *In re Graff,* 111 F.3d at 877.

Further, the specific errors identified in Appellant's declaration (i.e., the potential ambiguities) do not relate to Appellant's assertion that the

identified U.S. Patent is partially inoperative by reason of having claimed less than Appellant had a right to claim in that patent. The errors alleged by the declaration are all directed to potential ambiguities caused by antecedent basis problems. The Examiner has found that these antecedent basis problems identified in the declaration are "editorial in nature and correctable via Certificate of Correction" as the errors are not of such a type that create ambiguity of the claim scope. Answer 4.

We concur with the Examiner and we do not find that these antecedent basis problems which raise "potential ambiguities" identify an error in the patent claims under 35 U.S.C. § 112.[1] For example, with respect to claim 2, Appellant's declaration identifies that the phrase "analog integrated circuit" creates potential ambiguity. Fact 7. Originally filed claim 2 recites "[t]he analog integrated circuit of claim 1." Originally filed claim 1 recites "[a] temperature and process independent analog circuit comprising" and claim 1 does not recite any additional analog circuits. The standard for determining if patented claims are invalid under 35 U.S.C. § 112, is whether or not the claims can be construed or are they are insolubly ambiguous. *See Exxon v U.S., supra*. Thus, while it may be clearer for

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[1] During prosecution, of the reissue application the Examiner has made several rejections of the originally filed claims including a rejection of claims 21 and 37 under 35 U.S.C. § 112 second paragraph. See, for example, Office action dated June 18 2007. However these rejections are not before us as Appellant has amended the claims to overcome the rejections. See amendment dated September 18 2007 and Office action dated October 15, 2007. The ambiguities which gave rise to the rejection under 35 U.S.C. § 112 are not identified in Appellant's June 12, 2004 Declaration.

claim 2 to recite "[t]he *temperature and process independent* analog circuit of claim 1"[2] as in amended claim 2, the absence of the terms "temperature and process independent" from the original claim 2 does not create an ambiguity that would invalidate a claim under 35 U.S.C. § 112, second paragraph. The meaning of the term "the analog circuit of claim 1" of original claim 2 is readily discernable as referring to the temperature and process independent analog circuit of claim 1, as there is only one analog circuit recited in claim 1. The other antecedent basis issues identified in Appellant's declaration similarly identify potential ambiguities that Appellant has not shown rise to the level of ambiguities to invalidate a claim under 35 U.S.C. § 112, second paragraph.

Appellant's arguments rely heavily on the CCPA decision *In re Altenpohl* as holding that lack of antecedent basis in a claim is proper ground for reissue. Brief 10. One important difference between the situation presented by the facts of *Altenpohl* and the facts of the present appeal is that the court in *Altenpohl* noted that "[l]ack of an antecedent basis in a claim could render it invalid under 35 U.S.C. § 112." *Id.* at 1156. Thus, the court in *Altenpohl* had claims before it that contained a defect that could render them invalid and the patentee was attempting to correct this defect or error by reissue. In the instant case, Appellants have not shown that the antecedent basis issues identified in Appellant's reissue declaration would render the claims invalid.

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[2] The additions to the claim are shown in italics.

CONCLUSION

Appellant has not persuaded us of error in the Examiner's rejection of claims 1 through 45, 47 through 56, 58 through 68, and 70 through 72.

ORDER

The decision of the Examiner to reject claims 1 through 45, 47 through 56, 58 through 68, and 70 through 72 is affirmed.

AFFIRMED

ELD

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